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IN THE
Supreme Court of the United States

OCTOBER TERM, 1941.

No. 219

R. PICARD, INDIVIDUALLY AND AS ADMINISTRATRIX OF THE
ESTATE OF MARTIN SCHENK, DECEASED, ET. AL.,

Petitioners,

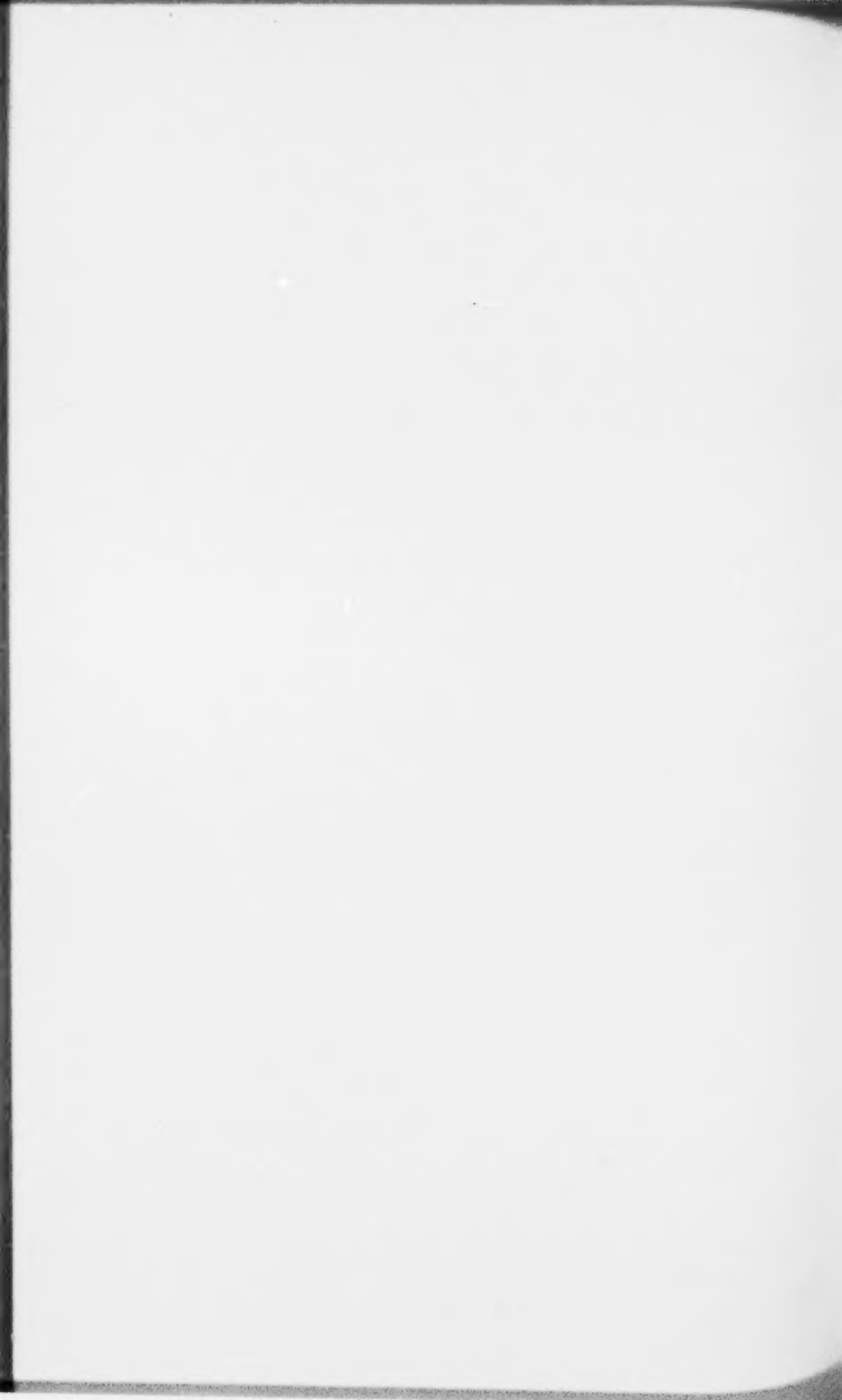
vs.

UNITED AIRCRAFT CORPORATION,

Respondent.

**PETITION FOR THE WRIT OF CERTIORARI TO THE UNITED
STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIR-
CUIT AND BRIEF IN SUPPORT THEREOF.**

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No.

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ESTATE OF MARTIN SCHENK, DECEASED, ET. AL.,
Petitioners,
vs.

UNITED AIRCRAFT CORPORATION,
Respondent.

**PETITION FOR THE WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE SECOND CIRCUIT.**

*To the Honorable Chief Justice of the United States and
the Associate Justices of the Supreme Court of the
United States:*

Your petitioners, R. Picard, individually and as administratrix of the estate of Martin Schenk, deceased, Jack Sommers and John E. Johnson, respectfully pray for the writ of certiorari to the United States Circuit Court of Appeals for the Second Circuit to review a judgment entered by that Court on May 28, 1942 (R. 1038).

Jurisdiction.

Jurisdiction is conferred by U. S. Code, Title 28, Sec. 347 (Sec. 240 of the Judicial Code), and U. S. Code, Title 28, Sec. 350, the writ being applied for "within three months."

Summary and Short Statement.

This is a patent infringement suit, but not an ordinary one. As petitioner construes the Circuit Court of Appeals' opinion, a controlling reason for its holding the patent in suit invalid on the ground of non-invention was that the Supreme Court through **"a pronounced new doctrinal trend"** has **"shown an increasing disposition to raise the standard of originality necessary for a patent."** That there is such trend or that the fundamentals of our patent system respecting the quality of inventive thought has been in anywise changed over what they have been for long years, the petitioners deny.

The suit was originally instituted by Schenk, the patentee, and his co-owner, Picard, against United Aircraft Corporation (R. 4), manufacturer of air-cooled, radial, internal combustion engines for airplanes, particularly the Pratt and Whitney engines commonly known as the Hornet and the Wasp. The death of the patentee and division of ownership occasioned changes in the parties, here not material (R. 1035).

The patent in suit (Schenk, Reissue 21,031, R. 173) discloses a completely automatic lubricating system for the valve gear of air-cooled, radial* engines such as are generally used in airplanes. The system is not applicable to engines of other types.

Claims involved are 3, 4, 14 (original claims), 17, 18, 19, and 20 (reissue claims).

* In a radial engine, the multiple cylinders surround the crank case, projecting radially therefrom in all directions in a single plane, with the valve gear at the outer ends of the cylinders all isolated from each other in widely separated relation and disposed of at many different angles and different elevations. Such an engine is to be distinguished from those in which the cylinders are arranged together in horizontal or V banks (in-line type engines) or in which the cylinders, though radially arranged, revolve about the central axis (rotary engines).

In any internal combustion engine, valves are provided to admit the charge and to exhaust spent gases. The valves are opened and closed by cam followers, push rods, and rocker arms, collectively known as the valve gear.

The problem of valve gear lubrication in an in-line type engine, wherein the valve gear are housed together in one or two long horizontal rows and are drained by gravity and so exhaust the spent oil, is simple. In a radial engine with no two cylinders in the same position, and all the valve gear necessarily separated from each other, with some above, some below, and others at the sides of the crank case, all in individual rocker arm boxes, other means must be employed.

The contribution of Schenk was the supplying of these means, the curing of the vital defect in an earlier tried automatic lubrication system, which because of the defect had been abandoned in favor of manual lubrication. In short, Schenk made the first successful automatic lubrication system for the valve gear of radial engines. It was an advance in the art of vast practical importance. With hand lubrication the motor would run for only ten hours without undue wear (D. C., R. 970). This period was extended by a "one-shot" pump operated by the pilot while in flight (D. C., R. 970). With Schenk's contribution an engine will run from one overhaul period to another (R. 138). It is a necessary feature for certainty of long sustained flights.

The Circuit Court of Appeals, in reversal of the District Court, found lack of invention, stating (R. 1045-46):

"We cannot, moreover, ignore the fact that the Supreme Court, whose word is final, has for a decade or more shown an increasing disposition to raise the standard of originality necessary for a patent. In this we recognize 'a pronounced new doctrinal trend' which it is our 'duty, cautiously to be sure, to follow not to resist.' "

In the foregoing statement, the Circuit Court of Appeals erroneously conceived that long established principles respecting invention no longer obtain and there is a new attitude of the Supreme Court toward the standard of

invention; and thus failed to give proper heed to century-old positive tests of invention from which the Supreme Court has never deviated, to-wit:

The grant of a patent makes it presumptively valid. *Agawam Woolen Co. v. Jordan*, 7 Wall. 583, 589, 1869; *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U. S. 428, 434, 1911.

That presumption must be overcome by a high degree of proof. *Coffin v. Ogden*, 18 Wall. 120, 124, 1873.

That residence of invention in the patent in suit is found in the following facts—facts of a character for long years considered pertinent by the Supreme Court and still so considered as we understand it:

a. **"The defendant abandoned its use of Heron's means * * * in favor of the patentee's improved construction"** (D. C., R. 973). That upon the advent of Schenk's invention the defendant took his new teaching and abandoned the old art is persuasive of invention. *Whitely v. Swayne*, 7 Wall. 685, 687, 1868.

b. **Respondent's witness, the engineer Heron, clearly showed that in his abandoned automatic lubrication "there was one inherent defect which was eliminated by Schenk"** (D. C., R. 972). That what had gone before was defective, the patent curing the defect, obviates any reluctance to sustain a patent. *The Barbed Wire Patent*, 143 U. S. 275, 282, 1892.

c. **"Schenk's disclosure was indubitably an improvement"** (Opinion of C. C. A., R. 1044). **"That automatic lubrication was an important development in the art is fully demonstrated by the extent to which since its development it has superseded more primitive methods"** (D. C., R. 970). The man who makes the improvement ought not to be denied the quality of inventor. **"In the law of patents it is the last step that wins."** *The Barbed Wire Patent*, 143 U. S. 275, 283, 1892.

d. **"Schenk substantially advanced the art"** (C. C. A. Opinion, R. 1049). **"The substantial utility of automatic lubrication in airplanes cannot be gainsaid"**

(D. C., R. 970). One whose discovery, though only an improvement, was of substantial advantage and highly useful is entitled to a patent. *Lawther v. Hamilton*, 124 U. S. 1, 6-7, 1888.

e. "Others, before Schenk, had unsuccessfully sought to achieve the same results" (C. C. A. Opinion, R. 1049). *Webster Loom v. Higgins*, 105 U. S. 580, 591, 1881.

f. Respondent "after it began to use his (Schenk's) device * * * advertised it, with fulsome praise, as a great step forward" (C. C. A. Opinion, R. 1049). *Kryptok Co. v. Stead Lens Co.*, 207 Fed. 85, 95; affirmed on the same opinion, 214 Fed. 368 (C. C. A. 9); *Linnville v. Milberger*, 29 F. (2d) 610, 613 (D. C., Kans.).

g. Respondent tried "by stealth to buy Schenk's patent" (C. C. A. Opinion, R. 1049). This has the same persuasive effect as bargaining for a license. *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U. S. 45, 56, 1923.

h. "There had never been any complete anticipation of Schenk's method" (C. C. A. Opinion, R. 1041). This fortifies the presumption of invention in it. *Cantrell v. Wallick*, 117 U. S. 689, 695, 1886.

i. The defense of aggregation was overruled since Schenk "accomplished a better method of co-operation between the drainage means", etc. (D. C., R. 974-975).

j. "The solution of drainage by gravity for automobile engines did not meet the problem involved in the radial engine of the airplane" (D. C., R. 969).

Epitomized the story of Schenk's contribution is this:

"The nearest was the Curtiss R-1454 engine about which the evidence has very largely centered" (C. C. A. Opinion, R. 1041);

"Moreover, the defendant itself before incorporating Schenk's disclosure into its infringing engines, tried even on a commercial scale a sumple drainage system which, like the Curtiss R-1454, depended upon direct suction on each rocker arm box. This sumple

construction was abandoned because, in the words of the defendant's own expert, Willgoos,

'We found that when we shut the engine down the oil which drained out of the rocker boxes to the bottom of the engine would build up a level sufficient to overflow the valve stems so that some of the oil would find its way down the valve guides, and if the valve on that particular cylinder happened to be open it was free to flow into the combustion chamber. And if a sufficient amount of oil collected in the combustion chamber in that manner there was danger of bending a connecting rod when you started the engine, due to excessive internal pressure in the cylinder.'

"This testimony that the defendant abandoned its use of Heron's means for closing the oil circuit—an invention apparently dedicated to the public—in favor of the patentee's improved construction is indeed highly persuasive evidence that Schenk disclosed a genuine improvement over Heron which constituted useful invention. I so hold" (D. C., R. 973).

Decisions of the Courts Below.

The District Court (R. 986) held claims 4 and 14 valid and infringed; the other original claims (2, 3, 5, 11, 15, 16) not infringed; and the reissue claims (17 to 20) invalid on reissue grounds.

In finding validity, the District Court referred to the importance of automatic lubrication; its substantial utility in airplanes; the inherent defects in respondent's attempted and abandoned automatic system, and the adoption by respondent of the patentee's improved construction (R. 968-974).

The Circuit Court of Appeals held claims 4 and 14 invalid for lack of invention (R. 1049); otherwise it affirmed the trial tribunal (R. 1049).

In a concurring opinion, Judge Frank was "reluctantly

constrained" to join in the opinion of his colleagues as "far better versed * * * in passing on patents" (R. 1051). Judge Frank believed the test of invention of his colleagues to be negative (R. 1052) and that their philosophy was that invention could not result from "trial and error" and "the exercise of persistent and intelligent search for improvement" (R. 1052). He said (R. 1054):

"In other words, it is highly likely that only an infinitesimal percentage of so-called inventions will be patentable under Judge Hand's test, if informedly applied."

Thus it will be seen that within the questions presented, as set forth below, there is involved the inquiry, paramount in importance to patentees, to inventors, and to the public, as to whether the Supreme Court has intended to invoke through "a pronounced new doctrinal trend a disposition to raise the standard of invention."*

Questions Presented.

The principal questions presented are:

1. Did the creation of a much needed mechanism for the automatic lubrication of the valve gear of radial airplane engines, which mechanism was found to be novel and found to have cured the vital defect in the only previous but unsuccessful and abandoned mechanism, involve invention?

2. In the consideration of the question of invention did the Circuit Court of Appeals correctly interpret the decisions of the Supreme Court within the last decade as exhibiting "a pronounced new doctrinal trend" showing "an increasing disposition to raise the standard of originality necessary for a patent"?

* Similar observations have been made by the Circuit Court of Appeals for the Sixth Circuit in *Murray-Ohio Mfg. Co. v. Brown Co.*, 124 F. (2d) 426, 428; *Cleveland Trust Co. v. Schriber-Shroth Co.*, 108 F. (2d) 109, 112; and the Circuit Court of Appeals for the Second Circuit in *Buono v. Yankee Maid Dress Corp.*, 77 F. (2d) 274, 276.

Subsidiary questions are:

3. Are claims of a patent, which more specifically define an invention within the disclosure of the specifications than did the original claims, invalid as reissue claims?

4. Are the claims in issue infringed?

REASONS RELIED UPON FOR ALLOWANCE OF THE WRIT.

For the reasons enumerated below, the writ prayed should be granted:

I.

By Reason of the Pronouncement and Application of the Statement That Because of "a Pronounced New Doctrinal Trend" the Supreme Court Has "Shown an Increasing Disposition to Raise the Standard of Originality Necessary for a Patent", the Circuit Court of Appeals Has Decided This Case in a Way Probably in Conflict With Applicable Decisions of the Supreme Court.

The Circuit Court of Appeals erroneously generalized from the decisions of the Supreme Court in recent years in patent cases without giving due consideration to the questions raised in those cases, or the nature of the thing patented, or the prior art applicable thereto.

The Supreme Court has not indicated by direct statement that it intended to raise the standard of invention or to change its attitude in respect to the inherencies of invention in patents. It is believed that had the Supreme Court desired to initiate a standard of invention departing from century-old rules, it would not have hesitated to so state; and that hence such a sweeping and revolutionary statement that "a pronounced new doctrinal trend" exists is a faulty inference and generalization.

II.

The Question of Whether Precedents of Long Standing Have Been Superseded by "a Pronounced New Doctrinal Trend" Raising the Standard of Invention Is of Transcendent Importance to Patentees, Patent Owners, and to Public as Affecting the Very Vitals of the Patent System. It Is a Question of Federal Law Which Should Be Settled by This Court.

The issue of invention in this instance because of the prime importance of the patented device in a vital industry emphasizes the desirability of a pronouncement by this Court as to whether there has been a change in the fundamental law of patents. The statement of the Circuit Court of Appeals is of such deep and wide implication that the statement should receive either the approbation or the disapproval of the Supreme Court.

The Circuit Court of Appeals has applied an almost wholly emasculatory rule to the question of invention.

The error of the Circuit Court of Appeals for the Second Circuit, in misinterpreting the opinions of this Court respecting the quality of invention, may be followed by that Court and other courts in future decisions. Already it has been cited and followed by a District Court in the Second Circuit in the case of *Wallace, Jr., doing business as Wallace Laboratories v. F. W. Woolworth Company*, decided June 9, 1942, 53 U. S. P. Q. 620. We quote from the District Court's opinion in the footnote*

* "Which is not to say that to devise that new combination would necessarily constitute patentable invention under the *present dispensation* governing such matters. (See *Picard v. United Aircraft Corporation*, Second C. C. A., No. 244 October Term, 1941, decided May 28, 1942 (53 U. S. P. Q. 563), both the opinion of the Court and the concurring meditations.) Apparently (1) the restricted monopoly of patent rights is not to reward 'the exercise of persistent and intelligent search for improvement'. Such is not deemed to 'reveal the flash of creative genius' specified as requisite

To the public, to patentees, to patent owners, and to the patent bar, indeed, to judges of the Federal Courts, the question of whether there has been a revolution in the standards of invention having its genesis in the Supreme Court is of prime importance.

III.

Unless There Has Been an Intent on the Part of the Supreme Court to Raise the Standard of Invention, the Striking Down of the Schenk Patent as Wanting in Validity, Heedless of Its Substantial Advance in a Vital Industry Where Others Had Unsuccessfully Sought to Achieve the Same Result, Is So Far a Departure From Established Rules as to Warrant Intervention and Review by the Supreme Court.

Every positive test of invention applicable to this record spells validity. But as Judge Frank points out a negative test was applied which would deny invention to the product of "the exercise of persistent and intelligent search for improvement" (R. 1052).

"The startling implication of Judge Hand's yardstick for invention" is that "it is highly likely that only an infinitesimal percentage of so-called inventions will be patentable" (Judge Frank, R. 1054).

in Cuno Engineering Corp. v. Automatic Devices Corp., 314 U. S. 84 (51 U. S. P. Q. 272).

And yet it must be recalled that genius has once been defined as the infinite capacity for taking pains. The approved approach to most unsolved problems is the studious and often plodding one, and no reliable substitute has been suggested, even though a solution thereby accomplished is not judicially deemed to attain to the status of patentable invention. Such is the *minimizing lens* supplied to a district judge for scrutinizing a patent submitted for adjudication."

Prayer.

WHEREFORE your petitioners respectfully pray that the writ of certiorari be issued to the United States Circuit Court of Appeals for the Second Circuit to the end that this cause be reviewed by this Court; that the judgment of the Circuit Court of Appeals be reversed; and that petitioners have such other and further relief as may be proper.

R. PICARD, individually and
as administratrix of the
estate of Martin Schenk,
Deceased,

JACK SOMMERS,
JOHN E. JOHNSON,

By GEORGE I. HAIGHT,
RAYMOND L. GREIST,
M. K. HOBBS,
Attorneys for Petitioners.





BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Opinions of Courts Below.

The opinion of the District Court is found at page 968 of the record. It is reported in 51 U. S. P. Q. 519.

The findings of fact and conclusion of law of the District Court begin at page 954 of the record.

The opinion of the Circuit Court of Appeals is found at page 1038 of the record. It is reported in 53 U. S. Q. 563.

Jurisdiction.

The judgment of the Circuit Court of Appeals was entered May 28, 1942 (R. 1038). /

The statute conferring jurisdiction is U. S. Code, Title 28, Sec. 347 (Section 240-A of the Judicial Code) and U. S. Code, Title 28, Sec. 350.

Statement of the Case.

The petition contains a summary of the most essential facts necessary to an understanding of the reasons relied upon for the allowance of the writ. However a recitation of ultimate facts in respect to the patent in suit is in order.

The patent discloses a system for automatically lubricating the valve operating mechanisms of radial engines. For each cylinder there are two sets of valve mechanism—inlet and exhaust. If for any reason any one of them does not receive lubrication, rapid wear will take place, the unlubricated valve gear will be ruined, and the engine will stop running—with the likelihood of serious consequence

to an aircraft in flight (R. 954). On the other hand, an excess of oil is equally bad. If the spent oil is not drained, fouling will interfere with the operation of the engine (R. 954-955). If a sufficient amount of oil is collected in the combustion chamber by reason of the fact that the oil is not exhausted, there is danger of bending a connecting rod when the engine is again started due to excessive internal pressure in the cylinder (R. 973).

Previous to Schenk's invention, the valve gear of internal combustion engines had been lubricated by introducing pressure oil into the cam follower or tappet and thence through a hollow push rod to a hollow rocker arm and thence through the latter to the valve stem (R. 955). Oil could be forced to the rocker arm boxes of radial engines by old methods and mechanism but it could not be drained therefrom back to the central reservoir by reason of the position of the cylinders. Hence while aeronautical engines with conventional in-line arrangement of cylinders had automatic lubrication for the valve operating mechanism, the radial engines as exemplified by the Pratt & Whitney Hornet and Wasp had to be lubricated by hand on the ground by means of a grease gun (R. 961).

This was time-consuming, required careful attention to each individual valve operating mechanism, with the possibility of one being missed unknowingly or through a clogged fitting (R. 961). The process was uncertain and unreliable (R. 961). After ten or twenty hours of engine use, it was advisable to repeat the whole process; and at each greasing process, all of the valve-operating mechanisms had to be separately adjusted to compensate for the wear which had taken place since last lubrication (R. 961).

Prior to Schenk's invention, no more than three radial engines were ever manufactured with an automatic system for lubricating the valve gear (R. 959). In 1924, Curtiss Aeroplane & Motor Co., Inc. entered into a contract with the United States Army for the manufacture and sale of

three Curtiss R-1454 engines of the air-cooled radial type. These engines were purchased by the Army for experimental purposes (R. 956). One of them is in evidence as Exhibit 118. Before the standard endurance 50-hour test had been completed, this engine was equipped with mechanism designed by the witness Heron to automatically lubricate the rocker arms and valve gear. It was a sumptuous system like Heron's which respondent abandoned in favor of Schenk's construction, the respondent's own expert pointing out the defect which caused the abandonment (R. 973). While under the Heron system, there was no difficulty in providing oil for the valve mechanism, the means of exhausting the spent oil was defective, with the resulting danger of broken or bent connecting rods (R. 973).

Heron's construction comprised (1) a circular manifold having a radius substantially less than the distance from the crank case to the top of the cylinder head (R. 971); (2) a separate scavenge pipe leading from a point at half the height of each rocker arm box to the circular manifold; (3) a horizontal pipe leading from the manifold to a (4) suction pump, which returned the oil to the central reservoir.

Each of the scavenge pipes was of L shape (originally a T-shaped pipe had led from each pair of rocker arm boxes) to permit of flow from the side of the rocker arm box to the circular manifold (R. 958). This return piping "for the majority of the rocker arm boxes is of such arrangement, by reason of its upper direction in whole or in part, as not to permit those rocker arm boxes (on the lower cylinders, R. 957) to be drained by gravity" (R. 958). Heron did not provide a dry sump (R. 958).

The vital defect in the Heron system was that it did not provide gravity drainage from the rocker arm boxes of each cylinder to a dry sump (R. 972-973). Perhaps suction from the manifold sufficed while the motor was in opera-

tion; but when the engine was shut down, the oil in the rocker arm boxes of the lower cylinders overflowed the valve stems, flowed down the valve guides, and, if the valve were open, into the compression cylinder itself (R. 973). This would cause bent connecting rods upon again starting the engine (R. 973).

Schenk's disclosure (R. 173) reveals that he provided a scavenging pipe 39 from an outlet in the lower part of each rocker box extending continuously downwardly to a connection with an outer ring manifold 40 through which the oil was conducted downwardly to a dry sump between and below the lowermost boxes. A scavenge pump returned the oil from the sump to the central reservoir for recirculation.

As regards infringement, the principal contention made in respect to Claims 4 and 14, held by the District Court to be infringed, was that passing the scavenge pipes from an upper rocker box to the one next lower and so around the engine for collection of the oil in a dry sump to be thence pumped to the central reservoir, eliminated the Schenk manifold. The District Court held (R. 977) that in substituting a number of scavenge pipes for connecting the rocker boxes in series around the circumference of the motor there had been appropriated every essential of Schenk's improvement (R. 977).

The reissue claims were attacked as being broader than the original claims, as untimely applied for, and as subject to the defense of intervening rights.

SPECIFICATION OF ERRORS.

1. The Circuit Court of Appeals, in determining invention to be non-existent, erred in applying "a pronounced new doctrinal trend" raising the standard of patentability.

2. The Circuit Court of Appeals erred in relying on negative tests of invention.

3. The Circuit Court of Appeals erred in holding that Schenk made no invention.

4. The Circuit Court of Appeals erred in holding the reissue claims (17, 18, 19, 20) invalid.

5. The Circuit Court of Appeals erred in not holding the claims in issue valid and infringed.

ARGUMENT.

The Schenk Patent Involved Invention.

Each act of Congress authorizing the grant of patents (1790, 1793, 1836, 1870, 1874) provides for the grant only to inventors, as the Constitution requires. Prior to 1836, a patentee received his grant entirely at his own risk of its defeat by proof of prior knowledge or use, and without any method of ascertaining whether such use, etc., existed. The Act of 1836 relieved inventors of this difficulty as far as possible by providing a tribunal, the Patent Office, before which the right of the applicant to his patent might be examined and determined. Since that time, the Federal courts and the Patent Office have developed a standard of measurement usable in determining invention.

It is now conceived, however, and applied prejudicially in the instant case, that the standard of measurement has itself changed. For over a century positive principles have been applied and reiterated. It is now set forth, apparently as a corollary of the "pronounced new doctrinal trend", that the producer's mind and mental processes be examined, as though by introspection, to search for a "flash of genius." *Cuno Engineering Corp. v. Automatic Services Corporation*, 314 U. S. 84, 91.

In this atmosphere, created by itself as we view it, and not imposed by the Supreme Court, the Circuit Court of Appeals falls into two errors, to petitioners' detriment.

It is submitted that in only one sense is the mental activity of the patentee pertinent: His act of conception must be creative, not *imitative*. Beyond this the fact of what he accomplished determines whether the originality displayed by him is mere mechanical plodding or pioneer-

ing. The law looks more to the *fact* than to the process by which it is accomplished. The Patent Act is designed to be practical, not metaphysical. It gives a reward for accomplishment beyond that of imitative plodding. This was the first error of the Circuit Court of Appeals. It considered the recent expression of the Supreme Court, "flash of genius", to be more than a verbal departure from the more usual expressions employed to distinguish between invention and mechanical skill.

The philosophy employed in the instant case would have negatived invention in the Edison electric light bulb. *Edison Electric Light Co. v. U. S. Elec. Lighting Co.*, 52 F. 300, C. C. A. 2. Edison's several thousand attempts were in the category of "trial and error."

The second error in the tests applied by the Circuit Court of Appeals was in the assumption that the Supreme Court has raised the standard of invention.* This was hasty generalization, for it is not believed that the Supreme Court has so intended. From two viewpoints generalizing from a decade of decisions is not warranted. First, the time interval compared with the age of the Patent System is insufficient. Second, since the amendment of the Judicial Code prior to the beginning of the decade, the Supreme Court considers fewer patent cases per unit of time.

A comparison of old and recent decisions as examples is persuasive that there is neither a new doctrinal trend nor a raising of standards.

As Judge Frank pointed out (R. 1056), the expression, "flash of genius", in the *Cuno* case, 314 U. S. 84, 91, is scarcely different than "flash of thought" in *Densmore v.*

*Fifty-five years ago it was said that the standard of mechanical skill is constantly being raised and the field of invention narrowed. *Wilcox v. Bookwalter*, 31 F. 224. A repetition of similar thought is interesting as a matter of history of the Patent System.

The expression in the *Wilcox* case followed within a few years the Supreme Court expression, "flash of thought", in *Densmore v. Scofield*, 102 U. S. 375, 378.

Scofield, 102 U. S. 375, 378, in 1880. The expression of the Supreme Court, "intuitive faculty of the mind", in *Hollister v. Benedict Mfg. Co.*, 113 U. S. 59, 72, 1885, is likewise similar. In the latter case "intuitive faculty" was contrasted with "the suggestion of that common experience which arose spontaneously, and by necessity of human reasoning."

Throughout the period beginning with our modern Patent System (1836) the *fact* of accomplishment has seemed to be the determining test, novelty established. It was so in the *Diamond Rubber Co. v. Consolidated Tire Co.* (Grant tire case), 220 U. S. 428, 1911; *The Barbed Wire Patent*, 143 U. S. 275, 283, 1892; *Webster Loom v. Higgins*, 105 U. S. 580, 1881; *Krementz v. Cottle Co.*, 148 U. S. 556, 560, 1893; *Eibel Process Co. v. Minnesota, etc.*, 261 U. S. 45, 1923; *Minerals Separation Co. v. Hyde*, 242 U. S. 261, 1916.

It was in the first of these cases that the Supreme Court said that "its simplicity should not blind us as to its character" and spoke also of "the light of the accomplished results." The same characterizations could have been applied with equal pertinence in each of the other cases.

Decisions within the decade do not depart from the precedents above. In the *Cuno* case, a thermostat employed in many electrical appliances was coupled analogously with an old cigarette lighter. The Court said it could not relax the rule of *Hotchkiss v. Greenwood*, 11 How. 248, 267, 1851, that "more ingenuity must be involved than the work of a mechanic skilled in the art." Attention was called to the fact that the *Hotchkiss* case was decided in 1851. This does not indicate a "new doctrinal trend."

Toledo Pressed Steel Co. v. Standard Parts, Inc., 307 U. S. 350, 1939, furnishes another within-the-decade example. There the patentee "put over the wick of a torch well known in the art, an inverted cup-like cap having holes in its sides. * * * The cap was also well known and had

been used as a part of other devices for the protection of kerosene and other flames." In support of its conclusion that mere mechanical skill was exhibited the Court cited *Hollister v. Benedict & Burnham Mfg. Co.*, 113 U. S. 59, 1885, and *Altoona Theatres v. Tri-Ergon Corp.*, 294 U. S. 477, 1935, fifty years later.

In the latter case, within the decade, the patentee added a flywheel to a shaft for speed constancy. In the art were numerous patents showing the like use of a flywheel in apparatus for producing motion pictures. Again the Court, in finding that no invention was involved, relied on precedents old and new.

In the last patent decision of the Court, *Williams Mfg. Co. v. United Shoe Machinery Corp.*, May 25, 1942, 53 U. S. P. Q. 478, the Court held that a new combination involving old mechanical construction combined them in a new way to produce an improved result. The claims were held valid.

It appears from the foregoing discussion and examples that the Supreme Court has not evidenced in its recent decisions "a pronounced new doctrinal trend" raising the standard of invention. In the decisions within the last decade the Court has referred to and applied rules which have existed since the origin of the patent system. These authorities are not shaken or undermined by recent decisions. The test and fact of accomplishment, where others tried and failed, is a positive test still applied. The patent cases decided by this Court in the last decade are treated in somewhat greater detail in an Appendix.

Schenk did not imitate; he created. And by his creation he accomplished. The application of a century of precedents is in concurrence with this view.

Applying the test of the difference between mere mechanical skill and invention, in the many forms in which those tests have been worded, Schenk made an invention of a high order. He made the first successful automatic

lubrication system for the valve gear of a radial engine.* The frank admission of the respondent and the failure of their efforts, the abandonment of the Heron system because of its inherent defects, and the adoption of the Schenk disclosure—all these spell invention positively. The importance and utility of the Schenk contribution cannot be gainsaid. Respondent gave credit by “fulsome praise” to automatic valve gear lubrication. The acknowledgment by respondent of the part which Schenk played in the creation of the system was an attempt to buy an interest in his patent by stealth.

Apparent simplicity does not deny invention. The possible argument that all Schenk did was to make intelligent use of the force of gravity is no more effective in the instant case than it was in the *Eibel Process* case. Similar argument could be made against the Morse telegraph patent, 15 How. 62, for in one sense all Morse did was to apply scientific principles of electro magnetic induction taught by Faraday.

The Schenk Patent Is Infringed.

The District Court found infringement of Claims 4 and 14, original claims. Finding these claims invalid, the Circuit Court of Appeals did not pass upon infringement. But infringement is clear. The joining of upper to lower rocker arm boxes around the outer edge of the motor by scavenge pipes accomplishes the same result in the same way as in Schenk. It is the full equivalence of the outer ring manifold shown in the Schenk drawings and disclos-

* The District Court found (R. 971) that the respondent's system for automatic lubrication was operable. The tests, however, were for motor endurance. The lubricating system was changed during the test. As the defendant's expert testified (R. 973) the defect of the Heron system would not become apparent during the operation of the motor while suction was available. It was after the motor stopped and the oil could drain into the cylinders that the defect appeared. The extent, if any, to which the Heron system was operable is more clearly demonstrated by its abandonment, the backward step to hand lubrication, and the adoption of the Schenk system, than by any conclusion drawn from other evidence.

ure, and comes literally within the claims, particularly Claims 4 and 14.

The Reissue Claims Are Valid.

The reissue was a proper one. The reissue claims are not broadened over the original claims; and the defendant has no intervening rights.

Conclusion.

From the foregoing, it is submitted that the Circuit Court of Appeals mistakenly believed that there exists in the Supreme Court "a pronounced new doctrinal trend" by which there is shown "an increasing disposition to raise the standard of originality necessary for a patent." By reason of the supposed existence of such a doctrine, and by reason of the fact that the Circuit Court of Appeals interprets "flash of genius" to exhibit a novel expression and thought, the petitioners were prejudiced and a patent stricken down which should have been sustained.

The question of whether this Court has departed from the rules and precedents by which invention is determined is vital and vastly important, not only in its application to this case, but to every member of the public, the residuary beneficiaries of the patent system.

WHEREFORE, your petitioners pray that their petition be granted; that the writ of certiorari be issued; that the cause be reviewed; and that the decree of the Circuit Court of Appeals be reversed.

Respectfully submitted,

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APPENDIX.

Like other courts, the Supreme Court speaks through decrees, judgments and orders. Reasons underlying its pronouncements are found in its opinions. We shall here briefly consider its decisions in patent cases beginning with the October Term 1931 (Vol. 284 U. S.). We have not counted as separate cases those in which the Supreme Court simultaneously disposed of certiorari to two different Circuits in respect to the same patent or patents. We have not included those cases which consider the relationship of the patent monopoly to anti-trust laws.

The number of cases given hereinafter cannot be completely reconciled because in some instances more than one patent was involved and each received a different treatment.

During the ten years covered, this Court decided fifty-four strictly patent cases. Six cases in which the question of invention was the heart of the decision and two in which the determining issue was aggregation are first here briefly treated. The remaining ones are thereafter more summarily covered.

Patents Held Void for Want of Invention.

1. *Altoona Publix Theatres v. American Tri Ergon Corp.*, 294 U. S. 477; March 4, 1935; Justice Stone. The patent involved the use of a flywheel for the recording and reproduction of linear sound records. The claims were held invalid for want of invention as distinguished from mechanical skill. A flywheel for speed constancy was not only old generally, but had been used for this purpose in the reproduction of disc and cylinder records. The

Court cited *inter alia*, *Hailes v. VanWormer*, 20 Wall. 353; decided in 1873.

2. *Essex Razor Blade Corp. v. Gillette*, 299 U. S. 94; November 9, 1936; Justice Roberts. Claims on a razor blade were held void for want of invention, the Court saying:

"The choice (of means to hold the blade in position relative to the cap and guard of the razor) was one between alternative means obvious to any mechanic."

3. *Mantle Lamp v. Aluminum Co.*, 301 U. S. 544; May 24, 1937; Justice Roberts. The Blair patent for heat insulated receptacle was held invalid for want of invention, all of the elements being old, and only mechanical skill being necessary to combine them.

4. *Honolulu Oil Co. v. Halliburton*, 306 U. S. 550; April 17, 1939; Justice Butler. Except for a difference in a valve, everything disclosed in the patent in suit was old in a prior patent. This prior patentee used a leaky valve for one purpose, and the patentee a tight valve for another. This was not invention.

5. *Standard Brands v. National Grain Yeast Corp.*, 308 U. S. 34; November 6, 1939; Justice McReynolds. Three patents on yeast nutrients were involved; the first was held invalid for want of disclosure. Following the Circuit Court of Appeals, the second patent was held invalid for want of invention, almost without discussion. The third patent was described as a union of two invalid patents, which could not make one good one.

6. *Cuno Engineering Corp. v. Automatic Devices*, 86 Law Ed. Advance Sheets 21; November 10, 1941; Justice Douglas. It was held not to be invention to take an old thermostat used commonly on switches and various kinds of electrical equipment and add it to an old wireless cigaret lighter. The Court cited *Hotchkiss v. Greenwood*, 11 How. 248, decided in 1851.

Patents Held Void on the Ground of Aggregation.

1. *Keystone Driller Co. v. Northwest Engineering Corp.*, 294 U. S. 42; January 7, 1935; Justice Roberts. The Downey patent in suit was held invalid because each of the elements was old and the combination was an aggregation.

2. *Toledo Pressed Steel Co. v. Standard Parts, Inc.*, 307 U. S. 350; May 29, 1939; Justice Butler. The patent was for a torch and perforated cap to cover the flame. It was held invalid because the aggregation of the two old elements which were combined were productive of no new joint function. Cited were *Hailes v. VanWormer*, 20 Wall. 353 and *Hollister v. Benedict*, 113 U. S. 59.

In not one of these cases can there be found any departure from long established principles. The cases cited in these opinions are apt in each instance and come from the years beginning a century ago. In none can we find any justification for the observation that there is shown an "increasing disposition to raise the standards of invention for a patent," or any new doctrinal trend.

It is thought that Justice Frank's observation in the case at bar (R. 1054) is apt and sound:

"In other words, it is highly likely that only an infinitesimal percentage of so-called inventions will be patentable under Judge Hand's test, if informedly applied."

Certainly, under such test, the after-the-fact, very simple invention of Alexander Graham Bell would have been held void for lack of invention (*Telephone Cases*, 126 U. S. 1, 1887). The Morse patent, in which the inventor put two old devices together in making the telegraph, would have also failed for lack of invention (*O'Reilly v. Morse*, 15 How. 62). The same could be said of Eli Whitney's cotton gin, the Barbed Wire patent and the Vacuum Tube, which

is the heart of long distance telephony, in the modern sense, of the movietone industry, and of radio. In very broad meaning, necessity is the mother of invention but, as pointed out by this Court in *Paramount Corp. v. Tri-Ergon Corp.*, 294 U. S. 464, 1935, sound moving pictures created their own demand. It can be equally well said that radio created its own demand, as did the sewing machine, the heart of which was Howe's invention of placing a hole in the needle near its point instead of at its head. To vastly multiply examples of this sort (as might be done) is here unnecessary. If this new doctrine of the Court of Appeals in the case at bar is to prevail, on the assertion that this Court gave it birth, it means that competition by inventors to outrace other inventors in the main will no longer exist; that capital will not venture in the promotion of important new discoveries; that the powerful urge to improve will disappear; and that the many strong virtues of our patent system—and indeed the system itself—will be practically destroyed.

There are numbers of patent cases in which the final question for a court's determination has been whether or not "invention" inheres in the patent. It is usually an easy question to ask, and often a difficult one to answer. In this respect, however, the question of whether the improvement is the product of mere mechanical skill, or is the product of inventive thought, is no more difficult than the question of what is reasonable conduct in a tort case, or reasonable time of delivery in a contract case, or reasonable action in self-defense in a criminal case; and so on throughout the entire field of the law.

Seldom is the science of the law an exact one. Almost invariably the faculty of judgment must be exercised in respect to facts. Pertinent facts in respect to the inherence of invention in a patent are of many different sorts. For instance, what has been the public's judgment of it;

what has been the judgment of competitors; was there in fact a contribution not obvious to one of ordinary skill; had others been seeking without finding; was there a need that those of ordinary skill in the art failed to meet; did the new contribution supplant what had gone before, and did it cure an existing deficiency. Such facts and many other facts of broadly similar nature provide the material upon which the judgment is to be exercised. Of course, there can no more be a definite, mathematical rule to fit all facts than there can be a rule by which one can measure with exactitude the differences between gross negligence, ordinary negligence, and slight negligence in causes where such distinctions are pertinent. Always, however, there are principles to guide one's use of facts in proceeding to the answer. Facts may emerge from confusion; principles cannot thus dwell.

During the ten years beginning with the October Term 1931, there were fifty-four decisions rendered by the Supreme Court in strictly patent cases—an average of substantially five a year. In the footnote below we have listed the names of the Justices writing the Court's opinion and the number of opinions by each.*

The cases decided involved the following issues:

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Jurisdiction, allied questions, and questions of practice	9
Questions of title.....	2
Contributory infringement by furnishing unpat- ented element	3
Equitable relief withheld because of suppression of evidence	1

* Justice Hughes	2	Justice Butler	8
Justice Brandeis	2	Justice Roberts	13
Justice Cardozo	4	Justice Stone	13
Justice McReynolds	4	Justice Reed	1
Justice Jackson	1	Justice Douglas	1
Justice Murphy	1	Justice Black	1

Per Curiam 3

Time of filing divisional application.....	1
Priority of invention between intervening applicants	1
Exhausted combination	1
Infringement by purchaser from restricted licensee	1
Amendment not within original contemplation...	1
Infringement only issue.....	1
File wrapper estoppel.....	2
Reissue questions	1
Intervening rights	1
Patents held void for anticipation.....	6
Patents held void for want of invention.....	6
Patents held void for aggregation.....	2
Patents held void because of public use more than two years before application filed.....	2

Of the cases in which patents were held void as anticipated, Mr. Justice Roberts wrote three of the Court's opinions and Chief Justice Stone three. Of the patents held void for want of invention as distinguished from mechanical skill, Mr. Justice Roberts wrote two opinions, Chief Justice Stone one, Mr. Justice Butler one, Mr. Justice McReynolds one, and Mr. Justice Douglas one. Of the patents held void because of aggregation (and we distinguish this from the question of resolving the difference between invention and mechanical skill) Mr. Justice Roberts wrote one and Mr. Justice Butler one.

The following were the six cases in which patents were held void because of anticipation:

1. *Electric Cable Joint Co. v. Brooklyn Edison Co.*, 292 U. S. 69; April 2, 1934; Justice Stone. The patent was on a protective device for a cable joint. It was held invalid in that it was anticipated by the prior art and described in printed publications. It was further said that it was an old method to produce an old result.

2. *Keystone Driller Co. v. Northwestern Engineering Corp.*, 294 U. S. 42; January 7, 1935; Justice Roberts. One patent was held not infringed. A second patent was held

void for want of novelty. The third patent in suit was held void on the grounds of aggregation and is listed in that category.

3. *Paramount Publix Corp. v. American Tri Ergon Corp.*, 294 U. S. 464; March 4, 1935; Justice Stone. There was involved a patent on the method of producing sound and photographic film for synchronous reproduction. The method of the patent was—(1) to simultaneously expose sound and picture on separate films, this was old; (2) to develop the negative separately; this was old; (3) to print simultaneously on positive film; this was old in respect to two negatives of a picture. HELD, the process did not possess novelty; it was an old process adapted to a new and closely analogous use. *Brown v. Piper*, 91 U. S. 37, was relied upon for authority.

4. *Smith v. Hall*, 301 U. S. 216; April 26, 1937; Justice Stone. The Smith patent previously held valid in *Smith v. Snow*, 294 U. S. 1, was held invalid as anticipated.

5. *Textile Machine Works v. Hirsch Textile Machines*, 302 U. S. 490; January 3, 1938; Justice Stone. The patent involved was for an attachment for knitting machines; the patent was held invalid as “plainly foreshadowed, if not completely anticipated”.

6. *Detrola Radio v. Television Corp.*, 313 U. S. 259; May 12, 1941; Justice Roberts. The patent was on automatic control of radio amplification. It was held invalid for want of invention, if there was any advance over the art; but the Court said the Heising patent was an anticipation, though designed for a different purpose.

In the cases decided on issues other than the issue of invention we find no expression that varies the result of the examination of the cases in which the issue of invention was the determining one.



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CHARLES ELMORE DROPLEY
CLERK

IN THE
Supreme Court of the United States

OCTOBER TERM, 1942

No. 219

R. PICARD, INDIVIDUALLY AND AS ADMINISTRATRIX OF THE
ESTATE OF M. J. SCHENK, DECEASED, ET. AL.,
Petitioners,

vs.

UNITED AIRCRAFT CORPORATION,
Respondent.

**BRIEF FOR RESPONDENT ON PETITION
FOR WRIT OF CERTIORARI**

DRURY W. COOPER,
C. BLAKE TOWNSEND,
Counsel for Respondent.



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IN THE

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UNITED AIRCRAFT CORPORATION,
Respondent.

No. 219

BRIEF FOR RESPONDENT ON PETITION FOR WRIT OF CERTIORARI.

Plaintiffs in a patent suit were defeated below because the Circuit Court of Appeals for the Second Circuit (opinion reported, 128 F. 2d 632) held "that the claims in suit are all invalid for lack of invention" (Rec. 1039, fol. 3115).

The District Court (43 F. Supp. 679) had dismissed the complaint as to all but two claims (4 and 14); upon defendant's appeal the Court of Appeals reversed as to those, and otherwise affirmed (Rec. 1049), holding all claims in issue to be invalid (Rec. 1039).

There has been no litigation in any other Circuit, nor any other action brought upon the patent. Thus the issue presented by the petition is, fundamentally, whether, all conflict being absent, this Court will review a simple holding by the Court of Appeals that a patent is invalid for lack of invention over the prior art, the Court having reached that conclusion.

Nor is this a case where it is asserted that the only infringements are within a single Circuit. So far as appears—and we believe the fact to be—many airplane engine builders in various parts of the country have been building their engines substantially in the way here charged to infringe.

Plaintiffs seek review for the stated reasons *first*: that the Court of Appeals pronounced and applied to the patent a standard of invention which it believed to be in accord with “ ‘a pronounced new doctrinal trend’ ” by which this Court has “ ‘shown an increasing disposition to raise the standard of originality necessary for a patent’ ” (Petition, p. 9); *second*: because the question so presented, with respect to earlier precedents, is asserted to be of importance sufficient to justify its settlement by this Court (Petition, p. 10); and *third*: because, if this Court has *not* so raised the standard of invention, plaintiffs assert that the Schenk patent would represent a patentable advance (Petition, p. 11).

We urge that the petition should be denied *first*: because petitioners’ stated reasons do not fairly reflect either the position or the opinion of the Court of Appeals (Rec. 1038); and *second*: because we feel that petitioners’ stated reasons do not accurately reflect the holdings of this Court, whether during the last decade or before.

I.

Petitioners have incompletely and incorrectly stated the opinion and holding of the Court of Appeals.

The petition assumes throughout, and in several places seems to assert (p. 2, bottom; p. 7, question 1), that the patentee, Schenk, was the creator of automatic lubrication for the valve gear of air-cooled radial engines such as are used on airplanes today, and for that reason made what

should be held to be a patentable invention. This is a fundamental error. The Court of Appeals found, expressly, and many of its findings were concurrent with those of the district court (*e. g.* Rec. 1041, fol. 3123), that Schenk's disclosure, although an improvement, was no more than that (Rec. 1044, fol. 3131). It was held not to amount to invention (Rec. 1045). What it did amount to, at the most, and stated by reference to the findings of the Court of Appeals, was simply this:

Completely automatic oiling systems for the valve gear of airplane engines were old before Schenk, both in air-cooled *radial* engines and in *V-type* engines.¹ Upon Schenk's own statement, the difficulties were common to both radial and vertical (in-line) engines (Rec. 1045, fol. 3134). In neither type of engine was there anything new in the mechanism for leading the oil from the oil pump *out* through the push rods and rocker arms to the joint between valve stem and rocker arm, thus accomplishing all desired lubrication. That was all found (and conceded by plaintiffs, in the Court of Appeals) to be old (Rec. 1040, fols. 3120-3122). If there *were* any invention, it could *only* be in the mechanism for draining the oil back from the rocker-arm boxes to a sump below the lowermost of the cylinders—as was also found by the Court of Appeals (Rec. 1041, fol. 3122; 1045, fol. 3134). As to that, the situation was that it was old in the Curtiss R-1454 engines—designed by Heron for the U. S. Government and three of which were tested, accepted and bought by the Government (Rec. 1041-3), and which must be considered a part of the prior art (Rec. 1042, fol. 3126)—to drain the rocker-arm boxes by *suction* to a “*sump-pump*”

¹ *I. e.* engines in which the cylinders are arranged in line, one behind the other, in two or more mutually-inclined banks, forming a “V”, like two spokes of a wheel; while in a “radial” engine the cylinders form a complete circle, like all the spokes (Rec. 1039, fol. 3116).

(Rec. 636-7; 663). That engine was not an abandoned experiment (Rec. 1041, fol. 3123; 1043, fol. 3128); and, whatever its defects in parts not here material, they were *not* with respect to its valve-gear lubrication system (Rec. 1042, fol. 3124). Thus *suction* return drainage of the valve oil, through a complete circular manifold to a sump-pump, in a radial, air-cooled, airplane engine, is established as part of the prior art (Rec. 1042, middle; 1043, fol. 3129). And *gravity* drainage, by manifolds to a pump below the lowermost cylinders, was also old (Rec. 1044, fols. 3130-1)—for example in the Packard inverted V-type engines which are shown in the Woolson patent (Rec. 892; 926). That was an engine in which the cylinders, arranged in two mutually-inclined banks, thus making a partial rather than a complete circle, were inverted like the two lowermost spokes of a wheel; and oil from the valve rocker boxes was drained by manifolds 36, and thence delivered to the oil reservoir by the pump 37, located behind 27 in Fig. 2, as the Court of Appeals found (Rec. 1043-4).

The Court of Appeals found that that engine "filled the hiatus" (Rec. 1043, bottom); the prior art had had *suction* drainage of a radial engine (helped by gravity in the case of the upper boxes), in the case of the Curtiss engine, and *gravity* drainage of an inverted V-type engine in this Packard construction (Rec. 1044, fol. 3130). Gravity drainage to an oil sump below the cylinders was also old in the Hispano-Suiza airplane engine (Rec. 929), in which the gravity-drained oil is shown in red at the bottom of the page, and there is also a separate oil tank (*i. e.* reservoir or sump), shown at the right.

Thus the most that Schenk can be said to have done was to apply gravity drainage, to a sump below the lowermost cylinders, to a radial engine; and on that we have his own statement that the difficulties were common to the radial and the in-line engines (Rec. 1045, fol. 3134), upon the latter of which (Woolson-Packard; Hispano-Suiza) that very thing had already been done.

What was presented to the Court of Appeals, then, was a simple case in which the engine itself and its valve gear, all suitably enclosed and hand-lubricated by grease, were old, and were in fact copied by the patentee from *respondent's* earlier engines (Rec. 1041, top). The *outgoing* train of oil passages, for application of automatic lubrication to the valve gear, was also admittedly old (Rec. 1040, fol. 3120); so that novelty, if any, could exist only in the return drainage arrangements (Rec. 1041, fol. 3122). For that, a complete circular manifold for a radial engine, with *suction* to a sump-pump (Rec. 636-7; 663), aided by gravity in the case of the upper boxes, was old in the Army's Curtiss engines; a *gravity* drain by manifolds to a pump below the cylinders, thence returned to a separate reservoir, was old in the Packard (Woolson) inverted V-type engines; and a separate sump below the lowermost cylinders, for gravity drainage, was old in many engines—*e. g.* the *Hispano-Suiza* airplane engine (Rec. 929)—wherever gravity drainage was wanted.

How then, there being no conflict and, in fact, no other litigation on the patent, can it be said that the Court of Appeals, in holding non-invention upon such a record, decided the case "in a way probably in conflict with applicable decisions" of this Court (Petition, p. 9)? We think that, such being the showing of the prior art, the holding of the Court of Appeals was plainly in harmony with the decisions of this Court, not alone during the decade just passed but in a continuous course since the passage of the present act over 100 years ago. This we shall show, as our second point.

II.

Holding of Court of Appeals was in accord with applicable decisions of this Court.

Gravity and suction having been alike old, and known alternatives, as means for draining return oil in airplane engines, as was also an oil sump below the lowermost point to be drained:

It seems clear that no "flash of creative genius" was revealed, as distinguished from the mere skill of any designer, in applying one rather than the other. Hence the holding below was within *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84 at page 91, middle, in which both ancient and modern cases are cited.

The holding is within the principles of, and entirely consistent with, *Standard Brands, Inc. v. National Grain Yeast Corp.*, 308 U. S. 34 at page 37, top; *Toledo Pressed Steel Co. v. Standard Parts, Inc.*, 307 U. S. 350 at page 356, top; *Honolulu Oil Corp. et al. v. Halliburton et al.*, 306 U. S. 550 at page 559, middle; *Mantle Lamp Co. v. Aluminum Products Co.*, 301 U. S. 544 at page 546.

"The choice was one between alternative means obvious to any mechanic; it did not have the quality of invention,"

within the holding of *Essex Razor Blade Corp. v. Gillette Safety Razor Co.*, 299 U. S. 94 at page 98, bottom.

What was done by petitioner here was certainly no more than the addition of the old flywheel in *Altoona Public Theatres, Inc. v. American Tri-Ergon Corp. et al.*, 294 U. S. 477 at pages 482-4; or printing the sound and picture tracks previously separately exposed and developed, together on one positive, as in *Paramount Public Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464 at pages 470-3.

What petitioner asserts as the advance is of the same order as the addition of the oil reservoir in *Electric Cable*

Joint Co. v. Brooklyn Edison Co., Inc., 292 U. S. 69 at pages 79-80—held not to be patentable. It is certainly less than was involved in the “high vacuum case”—which petitioner does not mention—*DeForest Radio Co. v. General Electric Co.*, 283 U. S. 664 at pages 678 and following, and pages 681-2.

Many other decisions of this Court are discussed by petitioner (Petition, pp. 18-30); but it seems that an analysis of each would be superfluous, both because the cases are fully illustrated by those already referred to, and because petitioners’ assertion concerning the others does not appear to be at variance with what we have said about those mentioned.

The whole basis of petitioners’ argument is that the Court of Appeals applied a standard of invention different from and higher than that laid down in the cases referred to (Petition, p. 23). We think that a full statement of the issue of invention, as it was actually presented to the Court of Appeals here, shows that the decision was in *accord* with the holdings of this Court, whether examined for the last decade only, or for the last hundred years.

Conclusion.

No reason for review by this Court is shown, since the decision below was simply an ordinary holding of lack of invention over the prior art, by a Court of Appeals on a full record, and without conflict. The petition does not accurately represent either the position of the Court of Appeals or the application to the facts established by this record of the pertinent decisions of this Court. We submit that the petition should be denied.

Respectfully submitted,

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